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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/884,487

Applicant(s)

PARK, JIN-HO

Examiner

Jeff Piziali

Art Unit

2629

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 17 July 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☒ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☒ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☒ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet



Jeff Piziali
26 September 2006

Continuation of 9. Other (including any explanation in support of the above items):

First and foremost, the applicants are cordially thanked for the "Revised Appellant's Brief on Appeal Under 37 C.F.R. § 1.192" filed 17 July 2003. However, a seemingly non-compliant issue has been discovered in the aforementioned response, requiring attention before examination may continue.

37 C.F.R. § 1.192(c)(5) requires the 'Summary of Invention' section of the brief must contain, "A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters."

However, the current 'Summary of Invention' section of the brief improperly includes an extraneous and unnecessary paragraph arguing how a prior art reference neglects teaching certain claimed subject matter of the instant invention (see Page 3, Lines 16-20 of the brief filed 17 July 2003). As such, the 'Summary of Invention' section of the brief cannot be considered "concise" in its present form.

37 C.F.R. § 1.192(c)(6) requires the 'Issues' section of the brief must contain, "A concise statement of the issues presented for review." MPEP § 1206 further requires, "Each stated issue should correspond to a separate ground of rejection which appellant wishes the Board of Patent Appeals and Interferences to review. While the statement of the issues must be concise, it should not be so concise as to omit the basis of each issue. For example, the statement of an issue as 'Whether claims 1 and 2 are unpatentable' would not comply with 37 CFR 1.192(c)(6). Rather, the basis of the alleged unpatentability would have to be stated, e.g., 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,' or 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure.' The statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues."

However, the current 'Issues' section of the brief improperly omits stating the basis of the alleged unpatentability (see Page 3, Lines 23-31 of the brief filed 17 July 2003). The "Farrington" reference is never appropriately identified by US patent number in the 'Issues' section. And the 'Issues' section omits anywhere identifying the 35 USC § 102(b) basis of each issue.

37 C.F.R. § 1.192(c)(7) requires the 'Grouping of Claims' section of the brief must contain, "For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable." MPEP § 1206 further requires, "If an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(8) the reasons why they are considered separately patentable. The absence of such a statement and argument is a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them."

However, the current 'Grouping of Claims' section of the brief includes statements that each of claim "Groups 1-3" respectively contain claims which "stand or fall together," without anywhere expressly stating that the claims in different groups do not stand or fall together (see Page 4, Lines 2-9 of the brief filed 17 July 2003). Which is to say, for example, the 'Grouping of Claims' section of the brief omits stating that the claims of "Group 1" (i.e., claims 10, 12-14, and 16) do not stand or fall together with the claims of "Group 2" (i.e., claims 11 and 15). It is noted here that the same ground of rejection (i.e., the "Farrington" reference) has been applied to all the pending claims. So the appellant must state which claims do not stand or fall together, when separate arguments are present (as is the case here) in the 'Argument' section of the brief.

MPEP § 1206 states, "Where, however, the appellant (A) omits the statement [that one or more claims do not stand or fall together -- i.e., that they are separately patentable] required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief. . . the appellant should be notified of the noncompliance as per 37 CFR 1.192(d)."

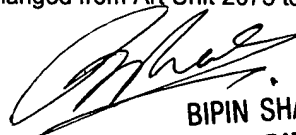
At least for such reasoning, the pending "Revised Appellant's Brief on Appeal Under 37 C.F.R. § 1.192" filed 17 July 2003 is deemed non-compliant.

Please note: The appeal brief has not been checked to the extent necessary to determine the presence of all possible non-compliance errors. If additional issues of non-compliance are discovered in a subsequent response, yet another Notification of Non-Compliant Appeal Brief will be necessitated. Appellant's cooperation is requested in correcting any other errors of which appellant may become aware in the brief.

The appellant is hereby notified that the examiner's art unit has recently changed from Art Unit 2673 to Art Unit 2629, please direct all future correspondence accordingly. Thank you.



Jeff Piziali
27 September 2006



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